

KNOBBE MARTENS OLSON & BEAR
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH CA 92660

5071



INTERNATIONAL APPLICATION NO. PCT/US98/01569

1A FILING DATE 02/25/98 PRIORITY DATE 02/25/97

10/13/99

DATE MAILED

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as

- ☐ a Designated Office (37 CFR 1.494),
☒ an Elected Office (37 CFR 1.495):

☒ U.S. Basic National Fee.

☒ Copy of the international application in:

- ☒ a non-English language.
☐ English.

☒ Translation of the international application into English.

☐ Oath or Declaration of inventors(s) for DO/EO/US.

☐ Copy of Article 19 amendments.

☐ Translation of Article 19 amendments into English.

☒ The International Preliminary Examination Report in English and its Annexes, if any.

☒ Translation of Annexes to the International Preliminary Examination Report into English.

☒ Preliminary amendment(s) filed 30 Aug 1999 and

☐ Information Disclosure Statement(s) filed and

☐ Assignment document.

☐ Power of Attorney and/or Change of Address.

☐ Substitute specification filed

☐ Statement Claiming Small Entity Status.

☒ Priority Document.

☒ Copy of the International Search Report and copies of the references cited therein.

☐ Other:

2. The following items MUST be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. Note a processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.

☒ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.

- ☒ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(h)).

- ☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date.

☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.

- ☒ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

3. Additional claim fees of \$ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

ALL OF THE ITEMS SET FORTH IN 2(a)-2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN ONE MONTH FROM THE DATE OF THIS NOTICE OR BY ☐ 21 OR ☒ 31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

4. Translation of the Annexes MUST be submitted no later than the time period set above or the annexes will be cancelled. Note processing fee will be required if submitted later than 30 months from the priority date.

5. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed: ☐ PCT/DO/EO/917

☒ Notice of Defective Translation

Winston Alvarado
National Stage Processing

☐ PTO-875

FORM PCT/DO/EO/905 (December 1997)

Telephone: Paralegal Specialist
(703) 305-6421



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Box PCT
Washington, D.C. 20231

09/380412

US APPLICATION NO.

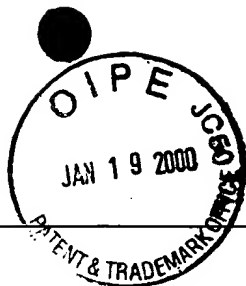
ATTACHMENT TO FORM PCT/DO/EO

NOTICE OF DEFECTIVE TRANSLATION

The received translation is defective because:

- ☒ (1) The text in the drawings has not been properly translated;
- ☐ (2) The number of claims in the International Application and the number of claims in the translation are not the same;
- ☐ (3) The translation of the International Application is incomplete as a number of pages are missing;
- ☐ (4) Other.

Winston Alvarado
National Stage Processing
Paralegal Specialist
Telephone: (703) (703) 305-6421



424 Rec'd PCT/PTO 19 JAN 2000
PATENT
09/380412
Case Docket No. RIEB3.001APC
Date: January 13, 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Ljungstroem, et al.
App. No. : 09/380,412
Filed : August 30, 1999
For : CORDLESS
COMMUNICATION
SYSTEM COMPATIBLE
WITH A PUBLIC MOBILE
COMMUNICATION
SYSTEM

Group Art Unit : Unknown

I hereby certify that this correspondence and all
marked attachments are being deposited with the
United States Postal Service as first class mail in
an envelope addressed to: Assistant Commissioner
for Patents, Washington, D.C. 20231, on

January 13, 2000

(Date)
Lowell Anderson
Lowell Anderson, Reg. No. 30,990

RECEIVED

28 JAN 2000

Legal Staff
International Division

TRANSMITTAL LETTER

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

ATTENTION: BOX MISSING PARTS

Dear Sir:

In response to the Notice to File Missing Parts of Application Under 37 CFR 1.53(f),
which was mailed by the Office on October 13, 1999, enclosed are:

- (X) An executed Declaration by Inventor(s).
- (X) A Proof of Authority of Administrator, Executor or Legal Representative.
- (X) An English translation of the Certificate of Heirship.
- (X) A Power of Attorney Form and Copy of Assignment.
- (X) An extension of time to respond for two (2) months is hereby requested.

01/24/2000 UNILKER 00000258 09380412

01 FC:198

640.00 CP



PATENT

Case Docket No. RIEB3.001APC
Date: January 13, 2000

Time Extension Fee:

<input type="checkbox"/>	one month	(\$110 large entity)
<input checked="" type="checkbox"/>	two months	(\$380 large entity)
<input type="checkbox"/>	three months	(\$870 large entity)

- ☒ A certified copy of an German application.
- ☒ A Notice to File Missing Parts.
- ☒ English Translation of the International Preliminary Examination Report.
- ☒ Two (2) sheets of drawings with corrected translation text.
- ☒ Return prepaid postcard.
- ☒ Fees as calculated below:

FEE FOR EXTENSION OF TIME (LARGE ENTITY)	two (2) months	\$ 380
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SURCHARGE 37 CFR 1.16(e)		\$ + 130
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SURCHARGE 37 CFR 1.492(f)		\$ + 130
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TOTAL OF ABOVE CALCULATIONS		\$ 640
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REDUCTION BY 1/2 FOR FILING BY SMALL ENTITY.

Note 37 CFR 1.9, 1.27, 1.28. If applicable, verified statement must be attached. \$ - 0

TOTAL FEES SUBMITTED HEREWITH		\$ 640
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- ☒ A check in the amount of \$640 to cover the above fees is enclosed.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 11-1410. A duplicate copy of this sheet is enclosed.

Lowell Anderson
Registration No. 30,990
Attorney of Record



RIEB3.001APC

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lungstroem, et al.) Group Art Unit Unknown
)
 Appl. No. : 09/380,412)
)
 Filed : August 30, 1999)
)
 For : PUBLIC MOBILE)
 COMMUNICATION SYSTEM)
 COMPATIBLE WIRELESS)
 COMMUNICATION SYSTEM)
)
 Examiner : Unknown)
)

PROOF OF AUTHORITY OF ADMINISTRATOR(TRIX), EXECUTOR(TRIX)
 OR LEGAL REPRESENTATIVE(S)

Assistant Commissioner for Patents
 Washington, D.C. 20231

Dear Sir:

The declaration for the above-identified application was signed on behalf of the

- ☒ deceased
☐ incapacitated

Inventor Frieder Pernice

(type or print name of deceased)

By Edith Pernice

(type or print name(s) of administration(trix), executor(trix), legal representative or all heirs)

Attached is

(check and complete (d) or (e))

- (d) ☐ a certificate of the clerk of a competent court or the register of wills that the appointment of the signatory is still in force and effect.
- (e) ☒ a certificate from the appropriate court that they are all the heirs and that the estate did not require the appointment of an administrator or that they have the authority corresponding to that of an administrator or heir.

006710 21408660

Appl. No. : 380,412
Filed : August 30, 1999

(also check and complete (f) and/or (g), if applicable)

- (f) ☒ The court papers mentioned above are not in English. An English translation of such papers are also attached.

NOTE: *The translation need not be sworn or affirmed. M.P.E.P. § 409.01(a)*

(g) ☐ A consular officer of the United States has authenticated the signature of the foreign officer attesting to the papers submitted as proof of authority.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 1/13/00

By: Lowell Anderson

Lowell Anderson
Registration No. 30,990
Attorney of Record
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
(619) 235-8550

S:\DOCS\JMC\JMC-3354.DOC
102899



Translation



Certificate Of Heirship

Anton Reinhard Friedl Pernice, born on March 5, 1937, last resided in Gross-Zimmern, died on August 23, 1997 and has bequeathed solely to:

his wife

Edith Irene Pernice, neé Dreher,

born 11.27.1943,

Schillerstr. 11, 64846 Gross-Zimmern.

Regarding the 63.75th part of the estate, succession is ordered. Succession is effective at the death of his wife. The right of the successor extends only to the property Schillerstr. 11 in 64846 Gross-Zimmern. The successor is relieved from the legal limitations. Successors are the legal heirs of the testator, at present his siblings

- a) Christina Weinhold neé Pernice
- b) Holger Pernice
- c) Malte Pernice
- d) Margaretha Kolb neé Pernice.

Dieburg, January 1, 1998

District Court

Trautman

Judge

Amtsgericht DieburgGeschäftsnummer
6 VI P 19/97**E r b s c h e i n**

Der am 05. März 1937 in Magdeburg geborene, zuletzt in Groß-Zimmern wohnhaft gewesene

Anton Reinhard Frieder Pernice

ist am 23. August 1997 daselbst verstorben und allein beerbt worden von:

seiner Ehefrau

Edith Irene Pernice geb. Dreher,
geb. 27.11.1943,
Schillerstr. 11, 64846 Groß-Zimmern.

Bezüglich des 63,75tel des Nachlasses ist Nacherbfolge angeordnet. Sie tritt ein mit dem Tode der Vorerbin. Das Recht des Nacherben erstreckt sich nur auf das Anwesen Schillerstr. 11 in 64846 Groß-Zimmern. Die Vorerbin ist von den gesetzlichen Beschränkungen befreit. Nacherben sind die gesetzlichen Erben des Erblassers, derzeit seine Geschwister

- a) Christina Weinhold geb. Pernice
- b) Holger Pernice
- c) Malte Pernice
- d) Margaretha Kolb geb. Pernice.

Dieburg, 27.01.1998
A m t s g e r i c h t

Trautmann
RichterIn am Amtsgericht

**Beglaubigt**

Unterschieden an der
Geschäftsstelle

006110 "ZIMMERN" 0119900

Translation



PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Vorlage	Ablage	105
Haupttermin		
Eing.: 06. SEP. 1999		
PA. Dr. Peter Riebling		
Searb.	Vorgelegt.	

Applicant's or agent's file reference 12172.2-D1409	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/DE98/00569	International filing date (day/month/year) 26 February 1998 (26.02.1998)	Priority date (day/month/year) 28 February 1997 (28.02.1997)
International Patent Classification (IPC) or national classification and IPC H04Q 7/38		
Applicant DETEMOBIL DEUTSCHE TELEKOM MOBILNET GMBH		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.	
2. This REPORT consists of a total of <u>7</u> sheets, including this cover sheet.	
<input checked="" type="checkbox"/>	This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).
These annexes consist of a total of <u>12</u> sheets.	
3. This report contains indications relating to the following items:	
I <input checked="" type="checkbox"/>	Basis of the report
II <input type="checkbox"/>	Priority
III <input type="checkbox"/>	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
IV <input type="checkbox"/>	Lack of unity of invention
V <input checked="" type="checkbox"/>	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
VI <input checked="" type="checkbox"/>	Certain documents cited
VII <input type="checkbox"/>	Certain defects in the international application
VIII <input checked="" type="checkbox"/>	Certain observations on the international application

Date of submission of the demand 18 September 1998 (18.09.1998)	Date of completion of this report 26 April 1999 (26.04.1999)
Name and mailing address of the IPEA/EP European Patent Office D-80298 Munich, Germany Facsimile No. 49-89-2399-4465	Authorized officer Telephone No. 49-89-2399-0

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/DE98/00569

I. Basis of the report

1. This report has been drawn on the basis of (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.*):

- ☐ the international application as originally filed.
- ☐ the description, pages _____, as originally filed,
pages _____, filed with the demand,
pages 1,2,2a,3-8, filed with the letter of 09 April 1999 (09.04.1999),
pages _____, filed with the letter of _____.
- ☐ the claims, Nos. _____, as originally filed,
Nos. _____, as amended under Article 19,
Nos. _____, filed with the demand,
Nos. 1-10, filed with the letter of 09 April 1999 (09.04.1999),
Nos. _____, filed with the letter of _____.
- ☒ the drawings, sheets/fig 1/2,2/2, as originally filed,
sheets/fig _____, filed with the demand,
sheets/fig _____, filed with the letter of _____,
sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/DE 98/00569

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-10	YES
	Claims		NO
Inventive step (IS)	Claims	1-10	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-10	YES
	Claims		NO

2. Citations and explanations

1). The international application PCT/DE98/00569 relates to a cordless communications system that is compatible with a public mobile communications system. Claim 1 claims a method for operating a cordless communications system with a mobile terminal of a public mobile communications system and independent Claim 9 claims a cordless communications system for operating a mobile terminal of a public mobile communications system.

2). The **prior art** is acknowledged in detail by the applicants in the description (see in particular pages 1 and 2) and is reflected in the preambles to Claims 1 and 9.

With regard to document WO-A-95/24106, which is mentioned in the prior art, it is emphasised that the authentication method in the said document is controlled via the public fixed network.

The disadvantage of the prior art is explained on page 2, paragraph 1, and consists in the fact that it is not possible to directly influence the base station of a cordless communications system via a mobile communications system, this having to be done

via the mains-borne fixed network.

- 3). The **invention addresses the problem** (cf. page 2, last paragraph) of devising a cordless communications system with safety functions which is compatible with a public mobile communications system and permits the use of corresponding mobile terminals. The invention also addresses the problem of devising a corresponding method.

- 4a). The problem of interest is solved by the advantageous combination of the technical features specified in Claim 1. Claim 1 reads:

method for operating a cordless communications system

with a mobile terminal (3) of a public mobile communications system,
with a base station (1) connected to the public fixed network (2), said base station being compatible on the radio interface with the mobile communications system, which has at least one authentication function,

characterised by

- reading/writing of data from/on at least one identification module (7) by the base station (1) using a read/write device, wherein parts of the data of the identification module (7) used in the base station (1) are identical with the data stored on the chipcard (SIM) of an access-dependent mobile terminal (3),
- processing of the read data using software implemented in the base station (1),

- authentication of the mobile terminal (3) in relation to the base station (1) using the data read and processed by the identification module (7), wherein the base station (1) fulfils the same functions and tasks as the home location register or the authentication centre of the mobile communications system, and when authentication is successful

- operation of the mobile terminal (3) via the public fixed network (2).

4b). The problem of interest is solved by the advantageous combination of the technical features specified in independent Claim 9. Claim 9 reads: cordless communications system for operating a mobile terminal (3) of a public mobile communications system with a base station (1) connected to the public fixed network (2), said base station being compatible on the radio interface with the mobile communications system, which has at least one authentication function,

characterised by

- a read/write device located in the base station (1) for reading/writing data from/on at least one identification module (7), wherein parts of the data of the identification module (7) used in the base station (1) are identical with the data stored on the chipcard (SIM) of an access-dependent mobile terminal (3), and
- software implemented in the base station (1) for processing the read data and authenticating the mobile terminal (3) in relation to the base station (1) using the data

read and processed by the identification module (7), wherein the base station (1) fulfils the same functions and tasks as the home location register or the authentication centre of the mobile communications system.

None of the international search report documents

alone discloses all the technical features of Claims 1 or 9 in their entirety. The subjects of Claims 1 and 9 therefore meet the novelty criterion stipulated in PCT Article 33(1) and (2).

The international search report documents do **not** suggest the subjects of Claims 1 and 9 either. The claimed subjects therefore meet the inventive step requirements (PCT Article 33(1) and (3)).

The subjects of Claims 1 and 9 are industrially applicable in the field of telecommunications. The industrial applicability requirements of PCT Article 33(1) and (4) are therefore satisfied.

- 5). Dependent Claims 2 to 8 define special embodiments of the method as per Claim 1, and dependent Claim 10 defines an advantageous configuration of device Claim 9. The dependent claims therefore likewise meet the novelty, inventive step and industrial applicability requirements (PCT Article 33(2) to (4)).

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/DE98/00569

VI. Certain documents cited

1. Certain published documents (Rule 70.10)

<u>Application No. Patent No.</u>	<u>Publication date (day/month/year)</u>	<u>Filing date (day/month/year)</u>	<u>Priority date (valid claim) (day/month/year)</u>
WO-A-98/28929	02 July 1998 (02.07.1998)	02 December 1997 (02.12.1997)	05 December 1996 (05.12.1996)

2. Non-written disclosures (Rule 70.9)

<u>Kind of non-written disclosure</u>	<u>Date of non-written disclosure (day/month/year)</u>	<u>Date of written disclosure referring to non-written disclosure (day/month/year)</u>
---------------------------------------	--	--

See Supplemental Box

Supplemental Box
(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: VI.2.

- a). This international preliminary examination report assumes that all the claims enjoy the priority of the filing date of the priority document. Should ~~this later prove not to be the case, document~~ WO-A-98/28929, which is listed in the search report, could become relevant.
- b). According to current PCT procedure, document WO-A-98/28929 does not belong to the prior art under PCT Rule 64. However, despite valid priority(ies) that document could become important during the subsequent national or regional patent proceedings, if the combination of features claimed in the independent claims proves not to be novel over the features disclosed by WO-A-98/28929 or another document of the same patent family (cf., for example, EPC Article 54(3) and EPC Article 56).

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Dependent Claim 3 is unclear (PCT Article 6).

The wording of the claim states that "further data is stored on the identification module (N.B.: in the singular)". Claim 3 refers back to one of Claims 1 or 2. In Claim 1 (cf. page 9, lines 12 and 13), **at least one** identification module (7) is used, on or from which data is read or written by the base station (1) using a read/write device. Claim 1 therefore also comprises a **plurality** of identification modules. The juxtaposition of one or more identification modules renders Claim 3 as a whole unclear. Claim 3 could be made clear if, for example, it were to read as follows: "...on the at least one identification module (7)...".